REMARKS

The present application was filed on March 5, 2002 with claims 1-27. Claims 1, 11, 12, 13, 17, 20 and 23 were the independent claims. In the outstanding Office Action, the Examiner: (i) rejected claims 1-6, 10-12, 17, 20, 21, 23, 24, 26 and 27 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,815,081 to Motohashi (hereinafter "Motohashi"); (ii) rejected claims 13-16 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,493,692 to Theimer et al. (hereinafter "Theimer"); and (iii) rejected claims 7-9, 18, 19, 22 and 25 under 35 U.S.C. §103(a) as being unpatentable over Motohashi in view of Theimer.

In this response, Applicants: (i) amend the specification to correct minor typographical errors; (ii) cancel claims 8, 11 and 17-19 without prejudice; (iii) amend claims 1, 9, 12, 13 and 20-23; and (iv) traverse the §102(b) and §103(a) rejections for at least the following reasons.

Applicants have amended pending independent claims 1, 12, 13, 20 and 23 to further clarify the subject matter of the invention. In general, Applicants have amended such claims to indicate that an environment-appropriate alert mode determination is based on context provided by an environment that the user is in. Support for the amendment may be found throughout the present specification, see, e.g., page 14, line 18, through page 16, line 7. No new matter has been added.

Regarding the §102(b) rejection of claims 1-6, 10, 12, 20, 21, 23, 24, 26 and 27, Applicants assert that Motohashi fails to teach or suggest all of the limitations in said claims for at least the reasons presented below.

It is well-established law that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Applicants assert that the rejection based on Motohashi does not meet this basic legal requirement, as will be explained below.

By way of example, the invention of amended independent claim 1 recites a method of providing a dynamic alert indication to a user of a signal receiving device, the method comprising the steps of: processing a signal transmitted from a signal transmitting device, to determine at least one environment-appropriate mode to be associated with an alert indication, wherein the processing

step includes the step of accessing information associated with a user of the signal receiving device and evaluating context provided by the environment that the user is in to determine the at least one environment-appropriate mode to be associated with the alert indication; and alerting the user of the signal receiving device via the alert indication that the signal has been received by the signal receiving device.

By way of example, the present specification, at page 14, line 18, through page 16, line 7, provides some illustrative embodiments wherein context provided by the environment is used to determine an environment-appropriate mode:

> It is contemplated that the device receives assistance from its environment. For example, a bluetooth-enabled device might receive a communication at the door to "sensitive" environments (also referred to as a context service environment) informing the device that it has entered an environment in which no audible modes of alert may be used or in which no modes of alert may be used. In such a situation, the cellular phone (or other device such as, for example, a personal digital assistant or a two-way pager) adjusts its behavior accordingly. It is further contemplated that for usability or other reasons, the device is configured to alert its user to the change in environment and the implications on future alerts in that particular vicinity. Additionally, the device forwards this information on to its awareness or context service or other infrastructure and does not act on the information directly. Alternatively, the device could act on the information itself and also forward the information to an awareness or context service or other component of the infrastructure. The environment might identify the type of environment it is, from a standardized list of environment types. From this information, the user could specify the preferred behavior for the specified type of environment and/or the service providers and device manufacturers could implement the required behavior for that environment.
>
> It is contemplated that the service provider's infrastructure is modified to support such a system. For example, infrastructure installed in sensitive environments might refuse to transmit calls or messages with audible alerts or it might modify the mode of alert to a non-audible one. Some particularly sensitive environments include those within hospitals, airplanes and blasting zones (such as appear in a highway construction site). In such environments, the use of cellular phone and other computer and communication devices might be banned. The present invention prevents the use of these devices within the sensitive environment. More specifically, transmitters within the sensitive environment may transmit a reconfiguration signal to these devices which precludes the device from transmitting further signals. Upon leaving the sensitive environment, the transmitter can send a second reconfiguration signal that returns the device back to its normal operating mode. While in the sensitive environment, the service provider could, possibly with the assistance

> of the transmitter, inform callers that the user is temporarily unavailable or a similar such message.
>
> It is also contemplated that a transmitter within a sensitive environment could send a reconfiguration signal that precludes the device from operating its radio at all (even in a listen-only mode) and that causes the device to turn its radio off. In this case, a second reconfiguration signal would be ineffective and the user will need to remember to turn the radio back on upon leaving the sensitive environment. Alternatively, the device could set an alarm and query the user to determine if the user has left the sensitive environment. If the user responds in the affirmative, the device could re-enable its radio; if not, the device could reset the alarm and re-query at a later time. Also, the transmitter's reconfiguration signal could suggest a time for that alarm to go off. It is further contemplated that the reconfiguration signal might indicate that the device should turn itself off. In this case, the user will be required to turn the device back on upon leaving the sensitive environment.

Motohashi is significantly different than the claimed invention. Motohashi discloses a radio paging receiver capable of providing a large number of announcing modes. Motohashi further discloses selecting an announcing mode "at a time when a current time instant is coincident with a preselected time instant" (Abstract of Motohashi). However, no where does Motohashi teach or suggest making an environment-appropriate alert mode determination based on context provided by an environment that the user is in.

For at least these reasons, Applicants assert that claims 1-6, 10, 12, 20, 21, 23, 24, 26 and 27 are patentable over Motohashi.

Regarding the §102(b) rejection of claims 13-16, Applicants assert that Theimer also fails to teach or suggest all of the limitations in said claims and, thus, the rejection based on Theimer does not meet the above-cited basic legal requirement of *Verdegaal Bros. v. Union Oil Co. of California.*

While Theimer discloses concepts of selective delivery of electronic messages in a multiple computer system, context and environment, Theimer does not teach or suggest making an environment-appropriate determination based on context provided by an environment that the user is in. That is, no where does Theimer teach or suggest delivery selection as it is related to appropriateness to the environment.

For at least these reasons, Applicants assert that claims 13-16 are patentable over Theimer.

Regarding the§103(a) rejection of claims 7-9, 18, 19, 22 and 25 over Motohashi in view of Theimer, Applicants assert that said claims are patentable over such combination for at least the reasons given above for the claims from which they respectively depend.

Further, Applicants assert that the combination of Motohashi and Theimer is improper.

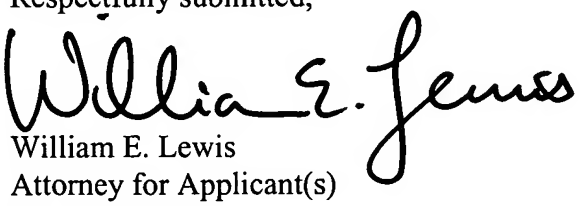
The Federal Circuit has stated that when patentability turns on the question of obviousness, the obviousness determination "must be based on objective evidence of record" and that "this precedent has been reinforced in myriad decisions, and cannot be dispensed with." In re Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002). Moreover, the Federal Circuit has stated that "conclusory statements" by an examiner fail to adequately address the factual question of motivation, which is material to patentability and cannot be resolved "on subjective belief and unknown authority." Id. at 1343-1344.

In the Office Action at page 8, the Examiner provides the following statement to prove motivation to combine Motohashi and Theimer: "[i]t would have been obvious to a person of ordinary skill in the art to [combine the references to] . . . allow the transmitting section to evaluate the signal and select the alert indication before sending it to the paging receiver."

Applicants submit that this statement is based on the type of "subjective belief and unknown authority" that the Federal Circuit has indicated provides insufficient support for an obviousness rejection. More specifically, the Examiner fails to identify any objective evidence of record in either Motohashi or Theimer which supports the proposed combination.

In view of the above, Applicants believe that the pending claims of the present application are in condition for allowance, and respectfully request withdrawal of the §102(b) and §103(a) rejections.

Respectfully submitted,



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